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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,659	01/15/2002	Gino W. Kennedy	1750.008	6613

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EXAMINER

GONZALEZ, JULIO C

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/047,659

**Applicant(s)**

KENNEDY, GINO W.

**Examiner**

Julio C. Gonzalez

**Art Unit**

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2,7,8,10,11,13 and 14 is/are rejected.  
7) ☒ Claim(s) 3-6,9 and 12 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities: claim 1 discloses a “conventional” air conditioning system. It is not clear as to what is meant by “conventional”. Also, the claim discloses “whereby said conventional air conditioning”. It has been hold that the functional “whereby” statement does not define any structure and accordingly serve to distinguish. In re Mason USPQ 127, 44 CCPA 937 (1957). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 discloses the term “adapted to cooperate”. It has been held that the term “adapted to” is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 7, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diefenthaler, Jr., in view of Wahnish and Mellum et al.

Diefenthaler, Jr. discloses an air conditioner compressor 37 having a single shaft with an engagable pulley 49 and a belt driven pulley 47 coupled to the main engine 1, an auxiliary plant 83, a motor 85 linked to the compressor 37 through a second pulley 91 (see figure 1). Moreover, it is disclosed that the pulleys may be engaged or disengaged, which it would make the pulleys function independently (column 6, lines 37-45, 46-56; column 7, lines 4-11).

However, Diefenthaler does not disclose explicitly using a motor linked to the compressor.

On the other hand, Wahnish discloses for the purpose of insuring adequate cooling for an air conditioning system, an engine 18 having a pulley 36 with a belt

34, which is coupled to a compressor 26 and the compressor 26 is coupled via a second pulley 32 to an electric motor 40 (see figure 5).

However, neither Diefenthaler nor Wahnish disclose that an auxiliary system may be used in a diesel truck.

On the other hand, Mellum et al discloses for the purpose of preventing damage to the truck's compressor and making an efficient cooling system that it is well known in the art to use auxiliary systems for use in diesel trucks (column 1, lines 10, 11, 30-33). Moreover, Mellum et al teaches that auxiliary power source may be placed within an enclosure 20 (see figures 1, 2A).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design an air conditioning system as disclosed by Diefenthaler and to modify the invention by linking explicitly a motor to the compressor for the purpose of insuring adequate cooling for an air conditioning system as disclosed by Wahnish and to use the auxiliary system in a truck for the purpose of preventing damage to the truck's compressor and making an efficient cooling system as disclosed by Mellum et al.

3. Claims 2, 10, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diefenthaler, Jr., Wahnish and Mellum et al as applied to claims 1 and 13 above, and further in view of Kennedy.

With regards to claims 2, 11 and 14, the combined air conditioning system discloses all of the elements above. However, the combined air conditioning system does not disclose using a horizontal diesel engine.

On the other hand, Kennedy discloses for the purpose of reducing the space needed for auxiliary generators, a generator 24, a diesel engine 12 and having brackets 28 between the generator and the engine (see figure 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the combined air conditioning system as disclosed above and to modify the invention by using a horizontal engine for the purpose of reducing the space needed for auxiliary generators as disclosed by Kennedy.

With regards to claim 10, the combined air conditioning system discloses all of the elements above. However, the combined air conditioning system does not disclose height and the power of the auxiliary engine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make a fifteen inch wall height for the enclosure of the

auxiliary engine and using a certain power output for the auxiliary engine since it has been held that discovering the optimum value of result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

4. Applicant's arguments filed 11/20/03 have been fully considered but they are not persuasive.

The remarks filed 11/20/03 argued that the prior art does not disclose utilizing an installed air conditioning. Diefenthaler, Jr. and Wahnish disclose using conventional air conditioning installed in vehicles (see figure 1 of Diefenthaler and figure 5 of Wahnish). Also, the claims disclose that the auxiliary engine is attached to a motor and a main engine, but the claims do not disclose that the “auxiliary engine is use for driving a generator which in turn delivers electricity to an electric motor”. Also, Mellum et al discloses the use of an auxiliary engine 22, which uses diesel fuel (column 3, lines 31, 32). With respect to the limitation of having a horizontal engine, Kennedy discloses using a horizontally oriented combustion engine (see abstract).

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the base references, Mellum et al, Wahnish and Diefenthaler, Jr. deal directly with air conditioning systems and auxiliary systems installed in vehicles and such references are in the same field of art.



7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., horizontal reciprocating engine; minimizing the number of components that are driven by the motor; using an auxiliary engine to drive a generator) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Allowable Subject Matter***

8. Claims 3, 4, 5, 6, 9 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the

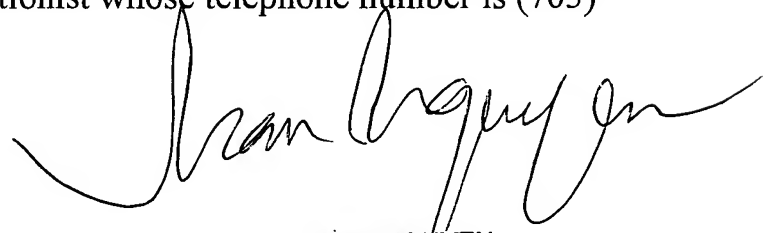
advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio C. Gonzalez whose telephone number is 571-272-2024. The examiner can normally be reached on M-F (8AM-5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2044.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**TRAN NGUYEN**  
**PRIMARY EXAMINER**

Jcg

March 5, 2004